

### **REMARKS/ARGUMENTS**

The Final Office Action dated April 6, 2005 has been carefully reviewed, and these remarks are responsive thereto. Applicants respectfully request entry of this Amendment, reconsideration of the application as amended, and allowance of the application.

Upon entry of this Amendment, claims 1-11, 17-28, and 30-37 will remain pending in this application. By this Amendment, Applicants cancel claims 38-48 without prejudice or disclaimer. These claims are canceled in an effort to expedite prosecution and to facilitate allowance of this application. Nothing in this action should be construed as an admission or acquiescence by Applicants that the rejection of these claims is proper and/or that Applicants agree in any way with the rejection of these claims. Applicants reserve all rights with respect to these canceled claims.

No new matter is included in this Amendment, and no additional claim fees are due as a result of this Amendment.

#### **I. THE CLAIMS PATENTABLY DISTINGUISH FROM O'SHAUGHNESSY**

The Office rejected claims 1-3, 5-8, 10, 11, 17-19, 21-24, 26-28, and 30-48 under 35 U.S.C. § 102(e) as allegedly anticipated by O'Shaughnessy, U.S. Patent No. 5,978,778 (hereinafter "O'Shaughnessy"). Additionally, claims 4, 9, 20, and 25 were rejected as allegedly obvious (35 U.S.C. § 103(a)) based on the disclosure of the O'Shaughnessy patent. Applicants respectfully traverse these rejections and request reconsideration.

One aspect of Applicants' invention, as recited in claim 1, relates to computer-implemented methods for creating a portfolio of issues. Such methods may include: (a) receiving user input, via a computer, identifying specific issues to be added to the portfolio, (b) receiving user input, via a computer, indicating a selection of one of a plurality of options for creating the portfolio, and (c) receiving user input, via a computer, indicating a past date for purchase of the portfolio. Once this input data is received, the portfolio is created and the portfolio's past performance is calculated by the computer based on the option selected and the past date. Applicants' independent claim 17 recites a computer-readable medium having a

computer-executable program stored thereon for creating a portfolio via a method as generally described above.

The information described in the O'Shaughnessy patent differs from the methods recited in Applicants' claims 1 and 17 (and their associated dependent claims). For example, Applicants' claimed methods include receiving user input, via a computer, indicating a past date for purchase of the portfolio and then calculating the portfolio's past performance based on, *inter alia*, this past date. This step is not taught or suggested in O'Shaughnessy. The Office points to column 5, lines 35-57, column 4, lines 7-25, and/or column 3, line 20 through column 4, line 24 of O'Shaughnessy as allegedly providing this teaching. Columns 3-4 in O'Shaughnessy compare the performance of various groupings of stocks, *e.g.*, since December 31, 1951. Column 5, lines 35-57 in O'Shaughnessy describe "Value Strategy Implications" relating to various groupings of stocks. Nothing in these portions of O'Shaughnessy, however, teach or suggest "receiving user input via a computer indicating a past date for purchase of a portfolio" and/or "calculating the portfolio's past performance, using a computer, based ... the past due date," as recited in Applicants' claims 1 and 17. While O'Shaughnessy generally mentions certain historical trends and information regarding past stock market performance, this disclosure in O'Shaughnessy falls far short of teaching or remotely suggesting Applicants' claimed method in which user input identifying specific issues to be added to a portfolio, as well as user input indicating a past date for purchase of the portfolio, are entered by the user via a computer. Additionally, O'Shaughnessy does not teach or suggest calculating a portfolio's past performance based on the past date input by the user.

For these reasons, Applicants respectfully submit that claims 1 and 17, as well as their corresponding dependent claims, clearly are not anticipated by the disclosure in O'Shaughnessy. Withdrawal of the rejections and allowance of these claims are earnestly solicited.

Applicants' independent claim 28 recites a system for creating a portfolio of issues. This claim recites that the system includes an input system that receives, *inter alia*, a designation of issues from a user to be included in the portfolio and a historical price associated with each issue. As described above, the O'Shaughnessy patent simply describes certain historical trends and information regarding past stock market performance. The O'Shaughnessy patent does not

describe a system for creating a portfolio of issues that includes an input system that receives a historical price associated with each issue designated by a user as recited in Applicants' claim 28. Accordingly, Applicants respectfully submit that claim 28 clearly is not anticipated by the disclosure in O'Shaughnessy. Withdrawal of this rejection and allowance of claim 28 are earnestly solicited.

Applicants' independent claims 34 and 30, respectively, recite a computer-implemented method and a computer-readable medium including a computer-executable program stored thereon for creating a portfolio of issues that: (a) receive identification of specific issues to be added to a portfolio from a user via a computer, and (b) receive identification of a past closing date for the issues from a user via a computer. Additionally, the method and program recited in these claims create the portfolio based on the specific issues identified by the user and historical prices obtained based on the past closing date identified by the user. Applicants respectfully submit that nothing in O'Shaughnessy teaches or suggests a method and/or a computer-readable medium that receives identification of a past closing date and/or uses this past closing date in determining a portfolio's past performance as recited in claims 34 and 30, respectively. Rather, the disclosure in O'Shaughnessy merely describes certain historical trends and information regarding past stock market performance. Withdrawal of these rejections and allowance of these claims are earnestly solicited.

In view of the foregoing, Applicants respectfully submit that claims 1-11, 17-28, and 30-37 patentably distinguish from the systems and methods disclosed in O'Shaughnessy. Withdrawal of these rejections and allowance of these claims are earnestly solicited.

## **II. CONCLUSION**

Applicants respectfully request entry and consideration of this Amendment because it is respectfully submitted that this Amendment places the application in condition for immediate allowance. Moreover, because this Amendment merely cancels certain claims, no new issues are raised by this Amendment that would require further searching and/or consideration by the Examiner. Entry of this Amendment also is appropriate in order to give Applicants an opportunity to respond to the new grounds of rejection first raised in the April 6, 2005, Final

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Office Action. Alternatively, entry of this Amendment is appropriate in the event of an Appeal, because this Amendment reduces potential issues on appeal (by reducing the number of claims present for a potential appeal) and clarifies Applicants' position with respect to the new grounds of rejection first raised in the Final Office Action.

If the Examiner believes that a telephone conference or a personal interview will be useful to advance the prosecution of this application and/or place the application in condition for allowance, he is invited to contact the undersigned attorney by telephone.

Applicants believe that no fee is required for this submission. However, if any fees are required, such as fees under 37 C.F.R. §§ 1.16 or 1.17, or if an extension of time is necessary that is not accounted for in the papers filed with this Amendment, the Commissioner is authorized to debit our Deposit Account No. 19-0733 for any necessary fees, including any necessary extension fees.

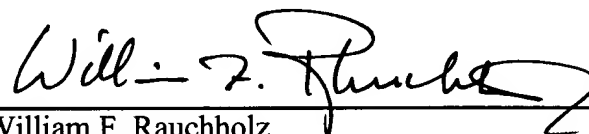
All rejections having been addressed, Applicants respectfully submit that this application is in condition for immediate allowance and respectfully solicit prompt notification of the same.

Respectfully submitted,

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